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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1023.P011US

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on September 1, 2005

Signature

Typed or printed name Mary Jo Bertani

Application Number

10/714,278

Filed

November 14, 2003

First Named Inventor

John M. Morgenstern

Art Unit

3644

Examiner

Dinh, Tien Quang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 42,321

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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Telephone number

September 1, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): John M. Morgenstern; James B. Bach; Alan E. Arslan
 Assignee: Supersonic Aerospace International, LLC
 Title: Methods For Configuring Aircraft To Meet Performance Goals And Shock Wave Disturbance Constraints
 Serial No.: 10/714,276 Filing Date: November 14, 2003
 Examiner: Dinh, Tien Quang Group Art Unit: 3644
 Docket No.: SAI.P011 US KB Ref. No.: 1023.P011 US

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REMARKS IN SUPPORT OF PRE-APPEAL BRIEF
REQUEST FOR REVIEW

Dear Sir:

This paper is being filed with the Pre-Appeal Brief Request For Review in response to the Final Office Action dated July 5, 2005, having a shortened statutory period expiring October 5, 2005. Further consideration is respectfully requested for the reasons set forth below.

Errors In Facts

On page 2 of the Final Office Action dated July 5, 2005, the Examiner states that the ideal equivalent area distribution goal curve is what one skilled in the art would want. The Examiner further states that relaxing a design constraint is what one skilled in the art would

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Serial No. 10/714,276
 September 1, 2005

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do to achieve an optimal design. If one wants to achieve the ideal equivalent area distribution goal curve, then it would be inconsistent to relax a design constraint to allow a design to have an equivalent area distribution that is below the ideal, as suggested by the Examiner. Applicant believes this inconsistency is an error in fact.

At the bottom of page 3 and top of page 4 of the Final Office Action, the Examiner further states that the summary of the Darden reference teaches relaxing a design constraint to be less than or equal to the ideal equivalent area curve. The statement is an error in fact, however, because Darden only teaches relaxing the bluntness of the nose, not relaxing a design constraint to allow the equivalent area distribution curve of the aircraft (not just the nose) to be at or below the equivalent area distribution goal curve, as set forth in independent Claim 1.

***Omission Of Essential Elements Required
To Establish A Prima Facie Rejection***

Claims 1-12, 29-39 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Darden.

The Examiner failed to establish anticipation and/or obviousness because there is no teaching or suggestion in Darden to relax a design constraint to require the equivalent area distribution curve of the aircraft to be at or below the equivalent area distribution goal curve as set forth in independent Claim 1. Darden only teaches how to determine the equivalent area distribution that produces minimum-overpressure or minimum shock signature. (Darden, p. 14). The Examiner points out that the ideal equivalent area distribution goal curve is what one skilled in the art would want. (Final Office Action, p. 2). Accordingly, Applicant submits that one skilled in the art would not be motivated to allow the configuration of an aircraft to depart from the goal curve, and therefore Darden does not anticipate or make obvious relax a design constraint to allow the equivalent area distribution of the aircraft to fall below/depart from the ideal equivalent area distribution.

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There is nothing in Darden that teaches or suggests the features in the claims would have been known or discovered even by one skilled in the art. The standard for anticipation requires that one skilled in the art could combine the publication's description of the invention with his own knowledge to make the claimed invention at the time the application was filed. MPEP § 2121.01. The Examiner has not provided any support for the premise that the features set forth in the dependent claims 2-12 and 30-39 were known or would have been obvious to one skilled in the art. Further, the Darden reference does not enable the features set forth in the claims as required under the standard set forth in MPEP § 2121.01. Accordingly, withdrawal of the rejection of Claims 1-12 and 29-39 as being anticipated by Darden is respectfully requested.

Further, the features set forth in the Claims are not inherent. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The term "inherent" is defined as "existing in someone or something as a natural and inseparable quality, characteristic, or right; innate; basic; inborn." Webster's New World Dictionary, Third College Edition, (Simon & Schuster, 1988). Applicant fails to understand how any of the features set forth in Claims 1-12 and 29-39 are inherent to the Darden disclosure. Such features are not shown or described in Darden, and were not known to one skilled in the art at the time the invention was made.

For example, Claim 29 requires "redistributing lift of a wing by configuring the wing with areas of far-field expansion ahead of areas of far-field compression." Darden is only concerned with the shape of the nose bluntness and does not even mention expansion and compression areas on the wing. Rather, Darden confines configuration changes to the fuselage forebody to determine the tradeoff between drag penalty and sonic boom disturbances. (Darden, p. 13).

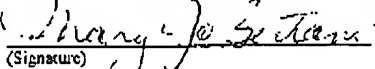
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The Examiner did not cite specific portions of Darden or any other reference to support his rejection of claims 2-12 and 30-39, but rather stated the features were obvious or inherent in the First Office Action dated January 12, 2005 and in the Final Office Action. Applicant requested further explanation and citations to relevant portions of the references to support the Examiner's position in response to the First Office Action but none were provided in the Final Office Action.

CONCLUSION

In view of the remarks set forth herein, Applicant believes there are errors in the rationale provided for rejecting all of the claims, as well as failure to establish a *prima facie* case for anticipation and obviousness. Claims 1-12 and 29-39 are believed to be in form for allowance and a notice to that effect is solicited. In the event it would facilitate prosecution of this application, the Examiners are invited to telephone the undersigned at (949) 251-0250.

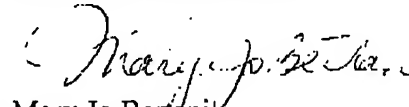
I hereby certify that this correspondence is being facsimile transmitted to the
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(Signature)

Mary Jo Bertani
(Printed Name of Person Signing Certificate)

September 1, 2005
(Date)

Respectfully submitted,


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